

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Lee M. Amaitis et al.
Serial No.: 10/667,923
Filing Date: September 22, 2003
Group Art Unit: 3713
Confirmation No.: 1611
Examiner: Christian E. Rendon
Title: SYSTEM AND METHOD FOR BETTING ON A
PARTICIPANT IN A GROUP OF EVENTS

MAIL STOP AF

Honorable Commissioner
for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

The following Pre-Appeal Brief Request for Review ("Request") is being filed in accordance with the provisions set forth in the Official Gazette Notice of July 12, 2005 ("OG Notice"). Pursuant to the OG Notice, this Request is being filed concurrently with a Notice of Appeal. Applicants respectfully request reconsideration of the Application in light of the remarks set forth below.

REMARKS

Claims 1-52 are pending in this Application. The Examiner rejects Claims 1-52. Applicants contend that the rejection of Claims 1-52 on prior art grounds contain clear legal and factual deficiencies, as described below. In a Final Office Action dated December 1, 2006 (hereinafter the "*Final Office Action*"), Claims 1-4, 6-7, 9-17, 19-20, and 22-27 were rejected as being unpatentable over U.S. Publication No. 2003/0199315 issued to Downes (hereinafter "*Downes*"), while Claims 5, 8, 18, 21, and 28-52 were rejected as being unpatentable over *Downes* in light of "Scarne's New Complete Guide to Gambling" by Scarne (hereinafter "*Scarne*"). The Examiner maintained these rejections in an Advisory Action issued February 28, 2007 (hereinafter the "*Advisory Action*"). Nonetheless, as Applicants noted in a Response to the Office Action filed November 2, 2005 (the "*November 2 Response*") and again in a Response to the Final Office Action filed (the "*February 1 Response*"), these rejections are deficient for at least several reasons. As a result, Applicants respectfully request reconsideration and allowance of Claims 1-52.

For example, *Downes* fails to recite, expressly or inherently, every element of Claim 1 for at least several reasons. First, *Downes* fails to disclose "receiving one or more first type of bets, each first type...comprising a bet that the total number of units earned by a particular participant over a course of a plurality of events will fall within a first range of numbers." In addressing this element, the Examiner asserts that "[a] first bet may be associated with quarterbacks in football that earn a number of units based upon number of completed passes in a season" and "[a] second bet may be associated with linebackers in football that earn a number of units based upon the number of quarterback sacks in a season." *Final Office Action*, p. 3. As Applicants previously noted (see, e.g., *November 2 Response*, p. 19-20), these examples are not, in fact, disclosed by *Downes*. In particular, *Downes* fails to disclose wagers associated with "quarterbacks in football that earn a number of units based upon [a] number of completed passes in a season" or "linebackers in football that earn a number of units based upon the number of quarterback sacks in a season" (emphasis added) as described by the Examiner in his example. Therefore, the cited reference does not support the Examiner's hypothetical examples.

Instead, *Downes* indicates that "[w]agers may be placed on where an individual player's statistics will rank compared to the statistics of other players of the same position (*e.g., 1st, 2nd, 3rd*)." ¶ 207, emphasis added. As a result, *Downes* does not disclose wagers "that the total number of units earned...will fall within a first range of numbers" as required by Claim 1 and instead discloses wagers relating to "where a particular [participant's] statistics will rank (*e.g., 1st, 2nd, 3rd*) compared to other [participants] for a given period of time." ¶ 210. As Applicants previously noted (see, e.g., *November 2 Response*, p. 19-20), for a rejection under 35 U.S.C. § 102 to be proper, however, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim," and "[t]he

elements must be arranged as required by the claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989); *In re Bond*, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990); M.P.E.P. § 2131 (emphasis added). Thus, *Downes* fails to disclose “receiving one or more first type of bets, each first type . . . comprising a bet that the total number of units earned by a particular participant over a course of a plurality of events will fall within a first range of numbers” (emphasis added) as required by Claim 1.

In the *Advisory Action*, the Examiner responds with a new argument, stating simply that “a Pari-Mutuel System inherently allows a person to place a bet on any number of situations.” *Advisory Action*, p. 2. The Examiner provides no evidence to support this assertion. Nonetheless, Applicants respectfully note that the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). Furthermore, “[i]n relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis added). By the Examiner’s own words, the system of *Downes* allows users to place multiple different types of bets. As a result, no single type of bet can properly be viewed as inherent to the teachings of *Downes* as alternative bets exist and no one type of bet necessarily flows from the teachings of *Downes*. Thus, not only does *Downes* fail to explicitly disclose “receiving one or more first type of bets...comprising a bet that the total number of units earned by a particular participant over a course of a plurality of events will fall within a first range of numbers” as required by Claim 1, but this element is also not an inherent part of *Downes* system.

Second, *Downes* does not disclose “determining the total number of units earned by the particular participant based at least in part on the positioning of the particular participant in each of the plurality of events.” In addressing this limitation, the Examiner asserts that “[t]he positioning may be the rank of the quarterbacks/linebackers over the season.” *Office Action*, p. 3. Nonetheless, as Applicants noted in the *February 1 Response* (p. 19-20), even assuming for the sake of argument that this is true, the example provided by the Examiner relates to *a single rank* of each of the relevant participants *over a single season* and not to “the positioning of the particular participant in each of [a] plurality of events.” Thus, even if the season is viewed as a series of games, neither the example provided by the Examiner nor *Downes* itself discloses “determining the total number of units earned by the particular participant based at least in part on the positioning of the particular participant *in each* of the plurality of [games]” (emphasis added) as *Downes* discloses determining a ranking for the players *only once*, at the end of the season. Applicants respectfully note that “[a]ll words in a claim

must be considered in judging the patentability of that claim against the prior art.” In re Wilson, 424 F.2d 1382, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970).

In the Advisory Action, the Examiner responds with a new argument, stating that “‘the total number of units earned’ also [sic] inherently found in the art as one of the steps towards figuring out which participate [sic] won the event and a participate’s [sic] rank is based on the player’s performance therefore it is a representation of a total number of units earned by the player.” *Advisory Action*, p. 2. Applicants respectfully note that the Examiner’s reliance on allegedly inherent properties of the *Downes* system is improper for reasons similar to those discussed above. Furthermore, with this new argument, the Examiner appears to be suggesting that the rank in the *Downes* system is based on the total number of units earned by the player. Applicants respectfully note that Claim 1 instead requires “determining the total number of units earned by the particular participant based at least in part on the positioning of the particular participant in each of the plurality of events” so, even assuming for argument’s sake the Examiner is correct, the Examiner’s description of *Downes* still fails to teach this element of Claim 1. Thus, *Downes* also fails to disclose this element of Claim 1.

As a result, *Downes* fails to disclose, teach, or suggest every element of Claim 1. Claim 1 is thus allowable for at least these reasons. Although Claims 17, 28, and 42 are of differing scope from Claim 1, Claims 17, 28, and 42 include elements that for similar reasons to those discussed with respect to Claim 1, are not disclosed by *Downes*. Claims 1, 17, 28, and 42 are thus allowable for at least these reasons. Applicants respectfully request reconsideration and allowance of Claims 1, 17, 28, and 42, and their respective dependents.

Double patenting Rejections

The Examiner fails to address the double-patenting rejection of Claims 1-5, 9-11, 14-18, 22, 26, 42, and 45-49 in the *Advisory Action*. Thus, Applicants were presumably successful in traversing those rejections in the *February 1 Response*. To the extent those rejections are still pending, Applicants submit those rejections are also deficient for the reasons identified in both the *November 2 Response* and the *February 1 Response*.

CONCLUSIONS

As the rejection of Claims 1-52 contain clear deficiencies, Applicants respectfully request a finding of allowance of Claims 1-52. To the extent necessary, the Commissioner is hereby authorized to charge any amount required or credit any overpayment to Deposit Account No. 02-0384 of BAKER BOTTS L.L.P.

Respectfully submitted,

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